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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,025	03/23/2001	Ming Zhang	ZHANG ET AL.-1	8516

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT PAPER NUMBER

2143

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/816,025

Applicant(s)

ZHANG ET AL.

Examiner

George C Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-2 are pending and have been examined.

Specification

2. The specification contains characters that are in a language that is other than the English language. The application must be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate. See 37 CFR 1.52(b)(1)(ii) and MPEP § 608.01.

Claim Objections

3. Claim 1 is objected to because of the following informalities:

Claim 1 is objected to because each claim must begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. See MPEP § 608.01(m).

Claim 1 recites the limitation "...it's...mail server..." The adjective "it's" should be "its".

Appropriate correction is required.

Claim Interpretation

4. The Applicant has not provided a clear definition for the term "pack" or "packaging" recited in claim 1 within the specification. Therefore, the Examiner will interpret this element by its plain meaning as if the term was interpreted by one of ordinary skill in the art. See MPEP § 2111.01. That is, the Examiner will interpret the term as preparing the email for delivery to a server. The limitation may also be

interpreted as using a compression algorithm to reduce the size of the email, however, in view of the Applicant's disclosure on page 2, paragraph beginning "(1) Transferring an email is based on packing...", the Examiner does not believe this interpretation is much different from "encoding" as explained in the specification which the plain meaning of this word as understood by one of ordinary skill is to convert data into a given format. The Applicant's assistance regarding this interpretation is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 1-2 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one

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sentence form only. Note the format of the claims in the patent(s) cited. (Examiner's emphasis added)

For example, claim 1 recites the limitation "Otherwise goes to step (4), and takes another try." This limitation is narrative. It is also indefinite because it is unclear as to what element of the claim "goes" and "takes another try".

Also, Claim 2 is replete with grammatical errors. The Examiner simply does not understand what is being claimed. It is not clear whether the message M, servers X or Y, the email D, or the packed email D' contain or generate information concerning the location that stores the email and/or the message of the sender or any such related subject matter.

Claim 1 recites the limitation "...a receiver y receives a message M from it's (sp) mail server Y". There is insufficient antecedent basis for this limitation in the claim.

It is unclear if the message M is being forwarded to receiver y from server Y or if the messages are distinct from one another.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by "The Joys of Viral Marketing" ("Joys").

Regarding claim 1, "Joys" discloses a method for email communication with the following characteristics.

Steps involved at sender side:

(1) a sender x (referred to throughout the reference as "You"; see page 2) packs an email D ("form") into D' ("a mini Web site") which is to be transmitted to a receiver y ("invitees");

(2) the sender x transmits the packed email D' to it's registered mail server X ("Evite.com"); (page 2, "You fill out a form...")

(3) the sender x or the server X sets the access permission of D' on the server X in such a way that D' on the server X may only be accessed by designated receiver y; (page 2, "...all the invitees...[are directed] to the Web, where they encounter a mini Web site...")

(4) the server X sends a message M ("email") to a server Y notifying that an email D' is accessible to one of its registered users y. (page 2, "Then, all the invitees get an e-mail...")

Steps involved at receiver side:

(1) a receiver y receives a message M from it's registered mail server Y. (page 2, "Then, all the invitees get an e-mail...")

(2) the receiver y downloads a packed email D' from server X based on the message in M; (3) the receiver y unpacks D' and reveals the original email data D. (page 2, "...all the invitees...[are directed] to the Web, where they encounter a mini Web site...")

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"Joys" does not expressly disclose if M is successfully sent, sending operation ends, otherwise, the operation goes to the following step and if the server X does not receive acknowledgement for M within certain predetermined times N, the server X sends an error report to user x; then ends the session, otherwise takes another try, however, "Joys" does disclose that the message M is an email as is known in the art (page 2, "Then, all the invitees get an e-mail..."). These limitations within "Joys" are inherent as demonstrated in "Request for Comments 821: Simple Mail Transfer Protocol". "SMTP" discloses that the above limitations are necessarily present in the limitation "email" as described in "Joys" (pages 14-16, section 3.6 "RELAYING", specifically the paragraph beginning "If a server-SMTP has accepted the task...", see the text "If a server-SMTP...finds that...the email cannot be delivered for whatever reason, then it must construct an 'undeliverable mail' notification message and send it to the originator of the undeliverable mail"). (Examiner's emphasis added) This disclosure shows a basis in fact to reasonably support the determination that the above limitations necessarily flow from the teachings of the applied prior art. See MPEP 2112.

Regarding claim 2, "Joys" discloses the method of claim 1.

"Joys" discloses following the above item 1, according to method that generates message M which consists of the location that stores the email and the message of the sender. (page 2, "...all the invitees get an e-mail directing them to the Web, where they encounter a mini Web site devoted to your event.")

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5 878 230 A to Weber et al;

US Patent 6 628306 B1 to Marchionda;

US Patent 6 484 196 B1 to Maurille;

US Patent Application Publication 2002/0065890 to BARRON;

Myers, J. and Rose, M. "Request for Comments 1939: Post Office Protocol – Version 3", Network Working Group, May 1996;

Evite, Inc. "Send an Evite", publicly posted 21 June 2000,
<<http://web.archive.org/web/20000621221217/www.evite.com/compose?linkTagger=header>>.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Thursday 1-2pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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